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EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2628

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,622

Applicant(s)

BARNES ET AL.

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-44, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-44, 48, and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/12/2006 has been entered.

Response to Amendment

2. The amendment filed on 6/12/2006 has been entered.

Response to Arguments

3. Applicant's arguments filed 6/12/2006 have been fully considered but they are not persuasive. Applicant argues the references do not teach the user selecting visually appealing physical adornment, however, applicants specification does not define what applicant intends to be visually appealing. The Rocky Mountain Article teaches the user can input his favorite image into the computer or choose from thousands of images which teaches the user is selecting visually appealing images. The Barrot et al publication teaches the user may select visually an appealing physical adornment when the user selects a casket, rooms with physical adornments surrounding or on the casket, a Hand Brushing Process 378, an Interior Finishing Process 380, etc. Thus, applicants' amendment to the claims and the corresponding

arguments are not persuasive to overcome the 35 USC 103 rejection since these references teach to one of ordinary skill in the art a user selecting a visually appealing physical adornments capable of being permanently fastened to a funeral item.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-21, 23-44, 48, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant amended independent claims 1, 23, and 48 to claim “visually appealing physical adornment”, however, the specification does not describe this. At page 21 line 1 “for instance, an appealing cap panel” is discussed, however, since an “appealing physical adornment” may be adornments other than the cap panel then the added claim limitation is broader than cap panel, thus, the scope of the claim is not manifested by the originally filed application. Additionally “an appealing cap panel” does not manifest a “visually appealing cap panel” since applicants’ specification did not specify which attribute of the cap panel was appealing. Thus, applicants’ originally filed specification does not convey that applicant had possession of the currently claimed invention.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-21, 23-44, 48, and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant amended independent claims 1, 23, and 48 to claim “visually appealing physical adornment”, however, the specification does not describe this. Applicant appears to be claiming only “visually appealing physical adornment” while the specification does not describe what applicant intends to be appealing. The specification at page 21 line 1 states “for instance, an appealing cap panel” is discussed, however, this does not state the attribute applicant intends to be appealing. Thus, this claim limitation is unclear. A very similar claim term “Aesthetically pleasing” was held to render a claim indefinite under 35 USC 112 second paragraph in *Datamize LLC v. Plumtree Software Inc.*, 75 USPQ2d 1801 (CA FC 2005). Since visually appealing and aesthetically pleasing are similar then the rationale given by the CAFC to aesthetically pleasing should be given to visually appealing.

Claims 23-44 are incomplete because a program by itself cannot perform the claimed functions and a program is not an apparatus.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-21, 23-44, 48 and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A) Signal claims

Claims 48 and 49:

These claims are program product claims however they do not properly claim a computer readable medium embodying computer readable instructions causing a computer to perform the claimed steps. Thus, these claims are programs per se. The program product needs to be embodied in a computer readable medium. Also the computer readable medium needs to be a part of the computer to impart functionality to the computer. Otherwise they are claiming descriptive material per se. In view of the Interim Guidelines these claims do not claim statutory subject matter.

Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility October 26, 2005.

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.p](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)
[df](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

Computer program per se claims are addressed at pages 52-55 and they are considered to be non-statutory. Computer readable medium embodying a functional descriptive material are addressed at pages 52-55, however, these claims do not claim computer readable medium.

These claims also are signal claims which are non-statutory. At pages 55-57 of the interim guidelines and on page 57 the Patent Office propose that "such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of § 101.". Applicant is encouraged to amend or cancel these claims since they are considered to be non-statutory.

B) Preemption

Claims 1-21 due to the broadening effect of the specification definition of image and display preempt the use of the underlying mathematical formula, the computer program or software, from being applied to all substantial uses of the underlying mathematical formula, the computer program or software. See the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility at pages 14, 20, 23, 35, and 59. Display is defined by applicant in the specification at page 10 lines 13-17 as "display 34 (e.g., a CRT monitor, an LCD display panel, and/or a speaker, among others)". Thus, when the claims claim displaying the composite image to a user the claims are claiming all substantial ways of displaying. Thus, all substantial uses of the compositing algorithm is covered by applicants claims. Please note these claims are opened claims due to the comprising clause. See MPEP 2111.03 Transitional Phrases.

Refer to pages 14, 20, 23, 35, and 59 of the PDF version of the Interim Guidelines.

Pages 14 lines 7-17 states:

The courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See Le

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Roy v. Tatham, 55 U.S. (14 How.) 156, 175 (1852) (“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127, 132, 76 USPQ 280, 282 (1948) (combination of six species of bacteria held to be nonstatutory subject matter). Accordingly, one may not patent every “substantial practical application” of an idea, law of nature or natural phenomena because such a patent “in practical effect be a patent on the [idea, law of nature or natural phenomena] itself.” Gottschalk v. Benson, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

Page 20 lines 12-16 states:

If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. If the examiner does not find such a practical application, the examiner has determined that the claim is nonstatutory.

Pages 23 states:

3. Determine Whether the Claimed Invention Preempts an Abstract Idea, Law of Nature, or Natural Phenomenon (§ 101 Judicial Exceptions)

Even when a claim applies a mathematical formula, for example, as part of a seemingly patentable process, the examiner must ensure that it does not in reality “seek[] patent protection for that formula in the abstract.” Diehr, 450 U.S. at 191, 209 USPQ at 10. “Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” Benson, 409 U.S. at 67, 175 USPQ at 675. One may not patent a process that comprises every “substantial practical application” of an abstract idea, because such a patent “in practical effect would be a patent on the [abstract idea] itself.” Benson, 409 U.S. at 71-72, 175 USPQ at 676; cf. Diehr, 450 U.S. at 187, 209 USPQ at 8 (stressing that the patent applicants in that case did “not seek to pre-empt the use of [an] equation,” but instead sought only to “foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process”). “To hold otherwise would allow a competent draftsman to evade the recognized limitations on the type of subject matter eligible for patent protection.” Diehr, 450 U.S. at 192, 209 USPQ at 10. Thus, a claim that recites a computer that solely calculates a mathematical formula (see Benson) or a computer disk that solely stores a mathematical formula is not directed to the type of subject matter eligible for patent protection. If an examiner determines that the claimed invention preempts a § 101 judicial exception, the examiner must identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical application thereof.

On pages 35 and 36 the guidelines states:

v. No Preemption Permitted

Even when a claim applies a mathematical formula, for example, as part of a seemingly patentable process, however, one must ensure that it does not in reality "seek[] patent protection for that formula in the abstract." Diehr, 450 U.S. at 191, 209 USPQ at 10. One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent "in practical effect would be a patent on the [abstract idea] itself." Benson, 409 U.S. at 71-72, 175 USPQ at 676; cf. Diehr, 450 U.S. at 187, 209 USPQ at 8 (stressing that the patent applicants in that case did "not seek to pre-empt the use of [an] equation," but instead sought only to "foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process"). Such limitations on process patents are important because without them, "a competent draftsman [could] evade the recognized limitations on the type of subject matter eligible for patent protection." Diehr, 450 U.S. at 192, 209 USPQ at 10; accord Flook, 437 U.S. at 590, 198 USPQ at 197. Thus, a claim that recites a computer that solely calculates a mathematical formula (see Benson), a computer disk that solely stores a mathematical formula, or a electromagnetic carrier signal that carries solely a mathematical formula is not statutory.

vi. Claim Must Be Considered as a Whole

Only "when a claim containing [an abstract idea] implements or applies that [idea] in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect," does "the claim satisf[y] the requirements of § 101." Diehr, 450 U.S. at 192, 209 USPQ at 10.

Pages 58 and 59 states:

ANNEX 5 Mathematical Algorithms

Claims to processes that do nothing more than solve mathematical problems or manipulate abstract ideas or concepts are complex to analyze and are addressed herein.

If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Benson, 409 U.S. at 71-72, 175 USPQ at 676. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

In practical terms, claims define nonstatutory processes if they:

– consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or

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– simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application.

Cf. Alappat, 33 F.3d at 1543 n.19, 31 USPQ2d at 1556 n.19 in which the Federal Circuit recognized the confusion:

The Supreme Court has not been clear . . . as to whether such subject matter is excluded from the scope of § 101 because it represents laws of nature, natural phenomena, or abstract ideas. See Diehr, 450 U.S. at 186 (viewed mathematical algorithm as a law of nature); Gottschalk v. Benson, 409 U.S. 63, 71-72 (1972)

(treated mathematical algorithm as an “idea”). The Supreme Court also has not been clear as to exactly what kind of mathematical subject matter may not be patented. The Supreme Court has used, among others, the terms “mathematical algorithm,” “mathematical formula,” and “mathematical equation” to describe types of mathematical subject matter not entitled to patent protection standing alone. The Supreme Court has not set forth, however, any consistent or clear explanation of what it intended by such terms or how these terms are related, if at all.

Certain mathematical algorithms have been held to be nonstatutory because they represent a mathematical definition of a law of nature or a natural phenomenon. For example, a mathematical algorithm representing the formula $E = mc^2$ is a “law of nature” — it defines a “fundamental scientific truth” (i.e., the relationship between energy and mass). To comprehend how the law of nature relates to any object, one invariably has to perform certain steps (e.g., multiplying a number representing the mass of an object by the square of a number representing the speed of light). In such a case, a claimed process which consists solely of the steps that one must follow to solve the mathematical representation of $E = mc^2$ is indistinguishable from the law of nature and would “preempt” the law of nature. A patent cannot be granted on such a process.

C) Useful, concrete, and tangible result

Claims 1-21, 23-44, 48 and 49 claim displaying the composite image to a user, however this does not claim a useful, concrete, and tangible result. These claims when read in light of the specification at page 10 lines 13-17 which states “display 34 (e.g., a CRT monitor, an LCD display panel, and/or a speaker, among others).” are directed to any type of display and do not manifest the display provides a useful, concrete, and

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tangible result in the funeral planning session. How does the display of a composite image guide the funeral planning session? *State Street Bank & Trust Co. v. Signature Financial Group Inc.* (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). *AT&T Corp. v. Excel Communications Inc.* (CA FC) 50 USPQ2d 1447. On page 1603 first paragraph the CAFC wrote in *State Street*:

Under *Benson*, this may have been a sufficient indicium of nonstatutory subject matter. However, after *Diehr* and *Alappat*, the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter-- but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-21, 23-44, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrot et al., U.S. Patent Application Publication No. 2002/00464046, and Lee, U.S. Patent Application Publication No. 2005/0102199, and the article describing the Rocky Mountain Monument & Vault's monument design software described in the article Funeral Home Online--Funeral Home Goes High Tech from the Utah Prime Time July 2000.

Barrot describes at page 4 paragraphs 0054-0057 and page 7 paragraphs 0081-084 a computer that is either standalone or networked to perform funeral advising and allows the user to select various funeral products for inclusion in the funeral and allows the user to view images of each of the funeral products.

Each of independent claims 1, 23, and 48 claim forming a composite image by superimposing the overlay image over the base image and the composite image includes a perspective view of the correlated item fastened to the funeral item; and displaying the composite image to a user.

Barrot replaces one web page image with another web page image as the user views the funeral products but it does not teach forming a composite image by

superimposing the overlay image over the base image. See paragraphs 0082 and 0157.

However, it should be appreciated that figure 5a shows the same viewing room but with different funeral products, however, these web pages are complete files not requiring compositing by superimposing a base image with an overlay image by the local computer. However, it should be noted that HTML web pages are formed by HTML code that makes references to image files causing the system to composite the images into the web page seen on the computer screen. However, these commands may or may not overlay one image onto another image.

Therefore, Barrot does teach displaying an image to the user showing the selected products together in a composite image formed before the selection process and stored in a database of images.

Lee teaches a shopping system that allows the user to select items to be formed into a single product and using a compositing process, see paragraphs 0047-0049, to display to the user a perspective view of the product to be purchased. See figures 4-6. The selected items are considered to be permanently fastened together since the intent is for the pieces to stay together as one even though they were assembled together from pieces to form one unit. 05-1026 DOREL JUVENILE GROUP, INC., v. GRACO CHILDREN'S PRODUCTS, INC., CAFC November 7, 2005. Even though screws were used the intent was for the seat to remain as one unit. V-Formation Inc. v. Benetton Group SpA, 74 USPQ2d 1042 (CA FC 2005). DECIDED: March 15, 2005. The rivets of the

accused device proved the intent of the accused device was to remain as an integral unit.

The Funeral Home Online--Funeral Home Goes High Tech article describes forming a composite image by overlaying a base image of a headstone with selected images of text, images, pictures, and just about anything, see paragraph 17.

The Rocky Mountain Article teaches the user can input his favorite image into the computer or choose from thousands of images which teaches the user is selecting visually appealing images. The Barrot et al publication teaches the user may select visually an appealing physical adornment when the user selects a casket, rooms with physical adornments surrounding or on the casket, a Hand Brushing Process 378, an Interior Finishing Process 380, etc. Thus, the references teach or suggest a user selecting a visually appealing physical adornments capable of being permanently fastened to a funeral item.

A detailed analysis of independent claims 1, 23, and 48 follows which is the same analysis made in the 12/12/2005 office action with the exception of addressing the added claim limitations.

Claim 1:

Barrot teaches a computer implemented method for guiding a funeral planning session, comprising:

displaying a base image of a funeral item (*Barrot displays many funeral items so the user may select a funeral item, many of the items such as caskets may be customized which allows the user to select another web page to view the images of a feature of the casket that may be selected for addition to the casket, thus, the initial view of a casket such as shown in figure 4d is a base image*);

superimposing an overlay image of a correlated item over the base image in response to a user selecting the correlated item (*when the user selects an area such as 77 in figure 4d the web page showing the image of that item replaces the web page shown in figure 4d*),

in such a manner as to form a composite image (*Barrot does not teach forming a composite image. Lee teaches forming a composite image of selected items to be included into a product and Lee provides motivation to do this in paragraph 0047. The Rocky Mountain article teaches forming a composite image of selected text to be etched onto the headstone and suggest placing objects onto the headstone which would similarly be viewed by the compositing process.*)

wherein the correlated item comprises a visually appealing physical adornment (*At page 21 line 1 of the specification "for instance, an appealing cap panel" is discussed, however, "an appealing cap panel" does not manifest a "visually appealing cap panel". Thus, applicants' specification did not specify which attribute of the cap panel was appealing. Since the specification does not describe what applicant intends to be appealing, then the claim should be read as if the claim is claiming any appealing attribute.*) capable of being permanently fastened to the funeral item (*Barrot teaches*

the user selects various physical objects capable of being permanently fastened to the casket. It would be reasonable to expect the user would select at least one appealing physical object to be placed onto the casket and it would be reasonable to expect the user would select at least one visually appealing physical object.), and

the composite image includes a perspective view of the correlated item fastened to the funeral item (Barrot illustrates in figure 5a various viewing room views which is a perspective view of the viewing room. Lee teaches forming composite image having a perspective view when the selected items to be included into a product are composited into a single view as illustrated in figures 4-6 and Lee provides motivation to do this in paragraph 0047.); and

displaying the composite image to a user (All three of the references displays to the user a composite image of selected items to the user.).

Barrot does not teach at lines 4-6 of this claim superimposing ... in such a manner as to form a composite image and does not teach at lines 7-8 the composite image includes a perspective view.

The article describing headstone designing superimposes an overlay image onto the base image of the headstone.

Lee teaches compositing separate graphic files to form a single image representing the items selected for inclusion into the single product. See paragraphs 0047 and 0063.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the image of the selected item for inclusion with

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the funeral item will be composited onto the image of the funeral item so the user will be able to view a perspective image of the customized funeral item on a display or printout during the funeral planning because the article in paragraph 15 describes giving the customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process and because the Lee article states this is preferable to having every possible combination of user selectable options stored as separate files as is done by Barrot.

Claim 23:

Barrot teaches an apparatus, comprising:

a memory (*web pages are stored in memory, see paragraphs 0052-0055*);

a database resident in the memory (*the web pages are stored in a database, paragraph 0055 describes a SQL server which is a database server*),

the database storing images associated with a plurality of funeral products (*the web pages store image of funeral products*); and

a program configured to access the database and retrieve a base image associated with one of the plurality of funeral items (*the web browser, a program, accesses the database to retrieve images of the funeral items*), and

display the base image (*the web browser displays the funeral item*), and

superimpose an overlay image of a correlated item of the plurality of

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funeral items over the base image (*when the user selects an area such as 77 in figure 4d the web page showing the image of that item replace the web page shown in figure 4d*),

in such a manner as to form a composite image (*Barrot does not teach forming a composite image. Lee teaches forming a composite image of selected items to be included into a product and Lee provides motivation to do this in paragraph 0047. The Rocky Mountain article teaches forming a composite image of selected text to be etched onto the headstone and suggest placing objects onto the headstone which would similarly be viewed by the compositing process.*)

wherein the correlated item comprises a visually appealing physical adornment (*At page 21 line 1 of the specification "for instance, an appealing cap panel" is discussed, however, "an appealing cap panel" does not manifest a "visually appealing cap panel". Thus, applicants' specification did not specify which attribute of the cap panel was appealing. Since the specification does not describe what applicant intends to be appealing, then the claim should be read as if the claim is claiming any appealing attribute.*) capable of being permanently fastened to the funeral item associated with the base image (*Barrot teaches the user selects various physical objects capable of being permanently fastened to the casket. It would be reasonable to expect the user would select at least one appealing physical object to be placed onto the casket and it would be reasonable to expect the user would select at least one visually appealing physical object.*), and

the composite image includes a perspective view of the correlated item fastened to the funeral item (Barrot illustrates in figure 5a various viewing room views which is a perspective view of the viewing room. *Lee teaches forming composite image having a perspective view when the selected items to be included into a product are composited into a single view as illustrated in figures 4-6 and Lee provides motivation to do this in paragraph 0047.*),

wherein the program is further configured to initiate the display of the composite image to a user (*All three of the references displays to the user a composite image of selected items to the user via a program.*).

Barrot does not teach at lines 7-8 of this claim *superimpose ... in such a manner as to form a composite image* and does not teach at lines 10-11 *the composite image includes a perspective view.*

The article describing headstone designing superimposes an overlay image onto the base image of the headstone.

Lee teaches compositing separate graphic files to form a single image representing the items selected for inclusion into the single product. See paragraphs 0047 and 0063.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the image of the selected item for inclusion with the funeral item will be composited onto the image of the funeral item so the user will be able to view a perspective image of the customized funeral item on a display or printout during the funeral planning because the article in paragraph 15 describes giving the

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customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process and because the Lee article states this is preferable to having every possible combination of user selectable options stored as separate files as is done by Barrot.

Claim 48:

This claim is a program product claim version of claim 23 and is rejected for the reasons given for claim 23, additionally, in one embodiment of Barrot's system the web browser on the local computer sends a request from the user to view a page to the network server, the network server, sends the requested web page, the local computer is directed by the sent web page to display the images associated with the web page. The memory storing the program is a signal bearing medium and the network is signal bearing medium during the transmission of the program.

Claim 49:

Barrot teaches the program product of claim 48, wherein the signal bearing medium includes at least one of a recordable medium (*the memory is a recordable medium since to have the program in memory the memory was recordable*) and a transmission medium (*the network is a transmission medium*).

Dependent claims 2-21 and 24-44 will now be analyzed.

Claims 2 and 24:

Barrot at least teaches storing the base image and the overlay image.

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Claim 3:

Barrot's web browser retrieves the image from the above described database, see claim 23.

Claim 4:

See figure 5a. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the selected item for inclusion in the viewing room will be composited into the virtual viewing room so the user will be able to view the customized viewing room because the Utah Prime Times article in paragraph 15 describes giving the customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process.

Claims 5 and 26:

See paragraphs 0054 and 0063. Applicant claim does not tell where the local computer is located. Paragraph 0054 describes a stand-alone computer and paragraph 0063 describes a local drive. At least paragraph 0054 describes a local computer.

Claim 6:

During inventory updating the web page images may be updated by the server
Web browsers cache server downloaded images and when a new image is required by the web page it is downloaded from the server.

Claim 27:

During inventory updating the web page images may be updated by the server
This claim is broad.

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Claims 7 and 28:

As the use selects funeral items the selections are stored in the database.

Claims 8 and 29:

The web pages of the funeral items include image data, see figure 4d.

Claims 9 and 30:

The family advisor software provides services such as ceremonies and products such as caskets.

Claims 10 and 31:

Prices are displayed in the web page, see paragraph 0081, thus prices were entered into the database.

Claims 11 and 32:

Prices are displayed in the web page, see paragraph 0081, thus prices were retrieved into the database.

Claims 12 and 33:

Themes are discussed with regard to personal expressions feature of the software see paragraph 0084 and figure 5a. Themes links the user to related products.

Claims 13 and 34:

Various themes are listed in paragraph 0084 which at least some correspond to the claimed themes such as hobby and religion.

Claims 14-15 and 35-36:

See paragraph 0084.

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Claims 16 and 43:

See paragraph 0080.

Claims 17 and 44:

See paragraph 0072, 0081, 0082 and 0089 for examples of urn, casket, corners and panels.

Claims 18 and 39:

See claim 9 paragraph 0020.

Claims 19 and 40:

See claims 9 paragraphs 0049 and 0149.

Claims 20 and 41:

This is a broad claim and is met by many aspects of Barrot's family advisor software such as the page shown in figure 4b.

Claims 21 and 42:

See figure 4d which shows at least three areas of the casket which can be customized. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the image of the selected item for inclusion with the funeral item will be composited onto the image of the funeral item so the user will be able to view the image of the customized funeral item on a display or printout during the funeral planning because the article in paragraph 15 describes giving the customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process.

Claim 25:

See paragraph 0063

Claim 37:

The casket is associated with the base image for the reasons given in claim 23.

Claim 38:

The selected funeral item is associated with the overlay image for the reasons given in claim 23.

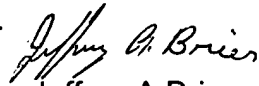
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jeffery A. Brier". The signature is written in a cursive, flowing style.

Jeffery A Brier
Primary Examiner
Division 2628